

REMARKS

Claims 1-17 remain pending in this application. Claims 1, 7, 10 and 13 are independent. No claims have been added, canceled, or amended by this Response. In view of the following remarks, reconsideration and allowance of claims 1-17 is respectfully requested.

Unpatentability Rejection over Wang et al. in View of Kalmanek, Jr. et al.

Withdrawal of the rejection of claims 1-5, 7-8, 10-11, 13-14, and 16-17 under 35 U.S.C. §103(a) as being unpatentable over Wang et al. ("Wang") (US 6009321) in View of Kalmanek, Jr. et al. ("Kalmanek") (US 7151772) is requested.

As a threshold matter, Kalmanek is not properly available as prior art against the present application. Kalmanek has a filing date of December 22, 1999, whereas the present application is a National Stage entry under the PCT of International Application serial. no. PCT/FI99/00676 filed on August 16, 1999. Thus, the effective U.S. filing date of the present application is August 16, 1999, a date that is before the filing date of Kalmanek.

Although Kalmanek purports to claim benefit under 35 U.S.C. §120 as a continuation-in-part (CIP) application of parent application serial no. 08/746,364 by Kadangode K. Ramakrishnan, now abandoned (hereafter "Ramakrishnan"), the benefit of Ramakrishnan's earlier critical reference date is not available in applying Kalmanek in the rejections of the pending claims in the manner set forth by the Examiner.

In particular, each portion of Kalmanek cited and relied upon by the Examiner in the various rejections finds absolutely no support in Ramakrishnan. Thus, for prior art purposes in the present rejections, Kalmanek's prior art date is December 22, 1999. If the Examiner maintains this rejection in the next non-final office action, then Applicant respectfully requests that Ramakrishnan be provided as a reference, and identification of applicable portions that support the rejection be provided, if such support exists.

In this regard, the Examiner's attention is invited to MPEP 2136.03¹ in which long-existing law and patent practice is discussed that clearly supports Applicant's arguments that the filing date of a U.S. Parent Application (*e.g.*, "Ramakrishnan") can only be used as the critical reference date if it supports the claims of the issued child (*e.g.*, "Kalmanek"). See also MPEP § 706.02(f)(1), examples 2 and 5 to 9 for proper determination of 102(e) prior art dates.

As stated in the MPEP, in order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the U.S. patent reference must have a right of priority to the earlier date under 35 U.S.C. 120 or 365(c) and the parent application must support the invention claimed as required by 35 U.S.C. 112, first paragraph. "For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art' " under 35 U.S.C. 102(e). *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981) (The examiner made a 35 U.S.C. 103 rejection over a U.S. patent to Pfluger.)

In *Wertheim*, the Pfluger patent (Pfluger IV) was the child of a string of abandoned parent applications (Pfluger I, the first application, Pfluger II and III, both CIPs). Pfluger IV was a continuation of Pfluger III. The court characterized the contents of the applications as follows: Pfluger I subject matter A, II-AB, III-ABC, IV-ABC. ABC anticipated the claims of the examined application, but the filing date of III was later than the application filing date. So the examiner reached back to "A" in Pfluger I and combined this disclosure with another reference to establish obviousness. The court in *Wertheim* held that the examiner impermissibly carried over "A" and should have instead determined which of the parent applications contained the subject matter which made Pfluger patentable. Only if B and C were not claimed, or at least not critical to the patentability of Pfluger IV, could the filing date of Pfluger I be used. The court reversed the rejection based on a determination that Pfluger IV was only entitled to the Pfluger III filing date. The added new matter (C) was critical to the claims of the issued patent.).

¹ MPEP 2136.03 (IV) - "PARENT'S FILING DATE WHEN REFERENCE IS A CONTINUATION-IN-PART OF THE PARENT - Filing Date of U.S. Parent Application Can Only Be Used as the 35 U.S.C. 102(e) Date If It Supports the Claims of the Issued Child".

Applicant submits that the decision in *Wertheim* is directly on point in the present rejections, and that Kalmanek is therefore not available as prior art against the present application.

Further, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference must teach or suggest all the claim limitations.***² Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.³

Discussion of the Deficiencies of Wang

As admitted by the Examiner in the Office Action, Wang is deficient in several ways with respect to recitations found in each of the independent claims 1, 7, 10, and 13, and the Examiner relies upon Kalmanek to overcome the admitted deficiencies of Wang. However, as discussed above, Kalmanek is not available as prior art, and the available prior art does not teach or suggest all the claimed limitations.

Accordingly, withdrawal of the rejection and allowance of claims 1-5, 7-8, 10-11, 13-14, and 16-17 in this application are respectfully requested.

Unpatentability Rejection over Wang and Kalmanek in View of Clarke et al.

Withdrawal of the rejection of claims 6, 9, 12 and 15 under 35 U.S.C. §103(a) as being unpatentable over Wang and Kalmanek in view of Clarke et al. ("Clarke") (US 5793752) is requested.

As discussed above, Kalmanek is not available as prior art against the present application, and therefore the applied art does not teach or suggest all the claimed limitations such that the rejection should be withdrawn.

² See MPEP §2143.

³ *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and *See* MPEP §2143.

Conclusion

In view of the above amendment and remarks, Applicants believe that each of pending claims 1-17 in this application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number indicated below.

For any fees that are due, including fees for extensions of time, the Director is hereby authorized to charge any fees or credit any overpayment during the pendency of this application to CBLH Deposit Account No. 22-0185, under Order No. 060258-0277084 from which the undersigned is authorized to draw.

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Respectfully submitted,

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